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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,845

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Jeffrey D. Jordan

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04/19/2004

NATIONAL AERONAUTICS AND SPACE ADMINISTRATION
LANGLEY RESEARCH CENTER
3 LANGLEY BOULEVARD
MAIL STOP 212
HAMPTON, VA 236812199

EXAMINER

NGUYEN, CAM N

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS10

Office Action Summary

Application No.

10/056,845

Applicant(s)

JORDAN ET AL.

Examiner

Cam N Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/27/03 (an election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5 & 8.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-11, in Paper No. 9 is acknowledged. The traversal is on the ground(s) that "the two listed inventions, while patentably distinct, nevertheless are so closely related to one another that examining all of the claims in a single application would not be a serious burden upon the Examiner. To the contrary, it is respectfully contended that it would be more efficient and expeditious to examiner the inventions together in one application, rather than two." This is not found persuasive because as stated in previous office action that the search required for Group I is not required for Group II. Therefore, if both Groups are searched, an additional burden is imposed on the Office due to two different searches being required.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Claim Objections

3. Claims 1-11 are objected to because of the following informalities:

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A. The term "improved" in the claims (1-11, line 1) is not further limiting and should be deleted. The inclusion of this term renders the claim confusing as to what is to be regarded as applicants contribution. If the instant invention is an improvement in an otherwise old process, then the use of the format set forth in 37 CFR 1.75(e) is suggested.

B. In claim 5, line 3, "being" should be --is--.

C. In claim 6, line 3, a comma -- , -- should be inserted after "percent".

D. In claims 7-11, line 1, --, low-temperature oxidation-reduction-- should be inserted after "improved" for consistency with the language in claims 1-6.

E. In claim 7, line 1, a comma -- , -- should be inserted after "claim 1".

F. In claim 8, line 1, "for the use" should be --for use--.

G. In claim 9, line 1, "for the use" should be --for use--.

H. In claim 10, line 1-2, "compound is a hydrocarbon" should be --compounds are hydrocarbons--.

I. In claim 11, line 1, "for the use" should be --for use--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102(e)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Bogdan et al., "hereinafter Bogdan", (US Pat. 6,495,487 B1).

Bogdan discloses a catalytic composite consisting essentially of a combination of a refractory inorganic support with from about 0.1 to 10 mass-% on an elemental basis of a halogen component, about 0.01 to 2 mass-% on an elemental basis of a platinum component, about 0.01 to 5 mass-% on an elemental basis of a Group IVA (IUPAC 14) metal component selected from the group consisting of tin and germanium, about 0.1 to 5 mass-% on an elemental basis of an indium component and about 0.05 to 5 mass-% on an elemental basis of a lanthanide-series metal component selected from the group consisting of cerium and lanthanum (see col. 16, claim 1). Bogdan further discloses that the catalyst may also contain other components or mixtures thereof which act alone or in concert as catalyst modifiers to improve activity, selectivity or stability. Suitable and known catalyst modifiers including rhenium, cobalt, nickel, iron, tungsten, molybdenum, chromium, bismuth, antimony, zinc, cadmium, and copper. See col. 9, In

66- col. 10, ln 4. Suitable refractory inorganic oxides including zirconia (see col. 4, ln 17).

Bogdan discloses the claimed catalyst, thus anticipates the claims.

The claimed metal contents are met by the reference (see col. 16, claim 1).

Regarding claims 7-11, the intended use limitations in the claims are noted.

However, they do not distinguish the product per se, since it is well settled that terms merely setting forth intended use for, or property inherent in, an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art. See, *In re Pearson 181*, USPQ 641. Also, "It is contrary to spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions where uses consist merely in employment of compositions; patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him". See, *In re Thuau*, 57 USPQ 324.

Citations

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Park (US Pat. 6,685,899 B1), Lim et al. (US Pat. 6,265,342 B1), Bozon et al. (US Pat. 4,294,726), Rausch (US Pat. 4,014,473), & Hindin et al. (US Pat. 4,088,435) are cited for related art.

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Conclusion

7. Claims 1-16 are originally pending in the application. Claims 1-11 are rejected. Claims 12-16 are withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (571) 272-1357. The examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number (571) 272-1700.


Cam Nguyen

Nguyen/cnn *CNN*

Primary Examiner

April 12, 2004

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